

Reply Brief Noted
/S.B./
8/6/09

Attorney Docket No.: 08914-0009001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Peter M. Perthou
Appeal No.: 2007-2838
Serial No. : 09/752,015
Filed : December 29, 2000
Title : KEY RING

Art Unit : 3673
Examiner : Suzanne Lale Dino Barrett
Conf. No. : 1179

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

I. THE THREE REFERENCES OMIT LIMITATIONS IN THE REJECTED CLAIMS PROPERLY CONSTRUCTED SUCH AS THE D-RING HAVING A U-SHAPED PORTION AND HAVING A BAR EXTENDING BETWEEN THE ENDS OF THE U-SHAPED PORTION OF LENGTH CORRESPONDING TO THE DISTANCE BETWEEN THE U-ENDS AND ENGAGING THE BAND OVER SUBSTANTIALLY THE ENTIRE LENGTH OF THE BAR FORMED WITH A GAP INTERMEDIATE THE U-ENDS OF GAP WIDTH ABOUT THAT OF THE CROSS SECTIONAL SPAN OF THE KEY HOLDING RING TO ALLOW THE KEY HOLDING RING TO PASS THROUGH THE GAP INTO THE D-RING DURING ASSEMBLY.

The Examiner's Answer states:

1. Claims 1,6,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514, and Momemers 4,523,443. Chen discloses a separable key holder comprising a pair of elongated, preferably flexible and rectangular straps (16, 18), most of one surface of each strap having thereon a patch of hook and loop fastening material (20 or 22) for releasable attachment to the comparable hook and loop fastening material of the other strap (col. 3, 11. 19-25, 35-39). An end of each strap is free of hook and loop fastening material, passes through a circular key holding element (12 or 14), and is folded back upon itself and sealed to itself, preferably by heat sealing, so as to hold the key holding element in looping engagement with the strap (col. 3, 11. 41-54; figs. 1, 2).

Jung discloses a combined nail clipper and key holder comprising an elongated nail clipper container (11), a triangular-shaped connecting member (14), one side of which has a gap in its central portion with a prong on each side of the gap that extends into nail clipper container 11 for fastening connecting member 14 to nail clipper container 11, and a key

ring (15) in looping engagement with connecting member 14 (col. 2, 11. 18-22, 45-50; figs. 1, 3).

Momemers discloses a key keeper comprising a D-shaped loop (3) having a U-shaped portion and, between the ends of the U-shaped portion, a bar having a gap (17) therein for receipt of keys onto loop 3 (abstract; col. 2, 11. 39-41; fig. 1). On each side of the gap is a leg (15 or 16) that projects into a cavity in a loop holder (2) (col. 3, 11. 44-47; fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Br. 4-7; Reply Br. 2-3).

As stated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, 11. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. See *KSR*, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap therebetween for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1).

Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1.42) also would be suitable for receiving a key ring. As

stated by the Supreme Court in KSR, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Regarding claim 11, Chen's key-holding elements 12 and 14 are attached to straps 16 and 18 preferably by heat sealing, and alternatively by stitching (col. 3, 11. 50-53), not by passing the ends of straps 16 and 18 through a gap in key-holding elements 12 and 14. However, one of ordinary skill in the art would have been led, through no more than ordinary creativity, by Momemers's disclosures that key-retaining loop 3 has a bar with a gap (abstract; fig. 1) and that keys can be inserted through the gap (abstract; col. 3, 1. 42; fig.1), to attach Chen's straps 16 and 18 through a gap so that straps 16 and 18 can be releasably attached to the D-ring of the combined disclosures of Chen, Jung and Momemers, and so that the loops at the ends of the straps can be formed in advance by heat sealing or stitching and later attached to key-holding elements 12 and 14.
Pp.2-6

These grounds of maintaining the final rejection are respectfully traversed.

The reference to the brief and reply brief in the prior appeal is inappropriate. The Board rejected the grounds of the previous final rejection, asserted new grounds and allowed us to amend the claims and seek reconsideration. We amended the claims to distinguish the invention over the three references, and the Examiner has ignored the limitations in the amended claims.

In KSR Int'l Co. v. Teleflex Inc., 82 U.S.P.Q. 2d 1385, 1396 (U.S. 2007), after stating the steps "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent in issue", the Court said, "To facilitate review this analysis should be made explicit." See *In re Kahn*, 441 F.3d 977, 988 (CAFed. 2006) ("[R]jections on obvious grounds cannot be sustained by mere conclusory statements, instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

"A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383

U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”)(quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))). *Id.* 1397.

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

“Both anticipation under §102 and obviousness under §103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art”. *Medichem, S.A. v. Rolabo, SL.*, 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

A. CLAIM CONSTRUCTION

“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry* 32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

* * *

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *in re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781,783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F. 2d 1048, 1051 (CCPA 1976)).

In *Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The claims as properly constructed as would be interpreted by one of ordinary skill in the art from reading the specifications requires proper interpretation of the limitations in claim 1 including "a D-ring coupling said band to said key-holding ring [having a cross-sectional span] and having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U-ends of the U-shaped portion of length corresponding to the distance between the U-ends and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U-ends of gap width about that of the cross-sectional span to allow the key-holding ring to pass through the gap into the D-ring during assembly." The specification explains in the paragraph beginning at page 2, line 21,

D-ring 11 has a U-shaped portion comprising legs 11A and 11B between the U ends of the U joined by bight 11C with a bar 11D formed with a small gap 11E in the middle extending between legs 11A and 11B of length corresponding substantially to the distance between the U ends, and residing in the loop formed by band 13. The width of gap 11E, typically about 1/8 inch wide, is about the span or diameter of the cross section of the material forming key holding ring 12 to facilitate insertion of the latter into D-ring 11 during assembly. The opposed portions of the band are preferably fastened together for most of its length as shown, to define an opening 13A accommodating bar 11D.

These limitations are clearly illustrated in FIG. 3.

Equally clear is that none of the references disclose the recited D-ring having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U-ends of the U-shaped portion of length corresponding to the distance between the U-ends

and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U-ends of gap width about that of the cross sectional span of the key holding ring to allow the key holding ring to pass through the gap into the D-ring during assembly. The Jung secondary reference does not disclose a D-ring having a U-shaped portion with a bar joining the ends of U portion with a gap width corresponding to the cross-sectional area of the key holding ring.

The Chen primary reference discloses circular loops at each end of a pair of flexible belting straps.

The Momemers tertiary reference does not disclose a D-ring, nor does the tertiary reference identify key getting loop 3 as a D-ring. It does not disclose a D-ring having a U-shaped portion with a bar joining the ends of the U-portion with a gap width corresponding to the cross-sectional area of the key holding ring. D means having the shape of the letter D. See definition 4 of the attached definition. "A reference is only good for what it clearly and definitely discloses. *In re Hughes*, 145 U.S.P.Q. 467, 471 C.C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 220 (C.C.P.A., 1961).

It is therefore impossible to combine the references to meet the limitations of the invention disclosed and claimed in this application.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of the claims is reason enough for withdrawing the rejection of them.

II. CLAIMS 2 AND 4 MEET THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE THE FOUR REFERENCES TO MEET THE LIMITATIONS OF THESE CLAIMS.

The Examiner's Answer states:

2. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemmers, as applied to claim 1 above, and further in view of Miller 1,704,137. Miller discloses a key holder comprising a strip of material, preferably leather, that is folded over at an end to form a loop through which a key chain passes, is closed by stitching (16) at the other end, and has one snap fastener (28) at each of its side edges intermediate the fold and stitching 16 to fasten together the side edges (p. 1, 11. 32-57; fig. 3).

The Appellant argues that the applied references do not suggest the desirability of the limitations in the Appellant's claims 2, 4, 7 and 9 (Br. 9).

Regarding claim 2, Chen discloses a web (straps 16, 18) looped through keyholding elements 12 and 14 (col. 3, 11. 19-25; figs. 1, 2). Attaching a D-ring to straps 16 and 18 would have been obvious to one of ordinary skill in the art for the reasons given above regarding the rejection of claims 1, 6 and 11. Like the Appellant's D-ring, that D-ring would have the ability to rotate through an angle of nearly 360 degrees and would permit rotation of a key-holding ring looped with it to ride along the inside of its U-shaped inside portion for substantially 180 degrees as required by the Appellant's claim 4.

With respect to the requirement of claims 7 and 9 that the key-holding ring is a spiral ring, Chen discloses in figure 4 what appears to be a conventional spiral key ring (12). Also, Jung discloses what appears to be a conventional spiral key ring (15) (fig. 1), and Chen's disclosure of a key holding ring (col. 3, 11. 19-20; figs. 1, 2) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use as the ring any known key holding ring such as the apparently-conventional spiral ring disclosed by Jung. Pp. 6-7.

These claims are dependent upon and include all the limitations of claim 1, and the reasoning set forth above establishing the patentability of claim 1 over the primary, secondary, and tertiary references is submitted to support the patentability of claims 2 and 4 so that further discussion of the quaternary reference is submitted to be unnecessary.

III. THE CLAIMS PROPERLY CONSTRUCTED CANNOT BE MET BY THE COMBINATION OF REFERENCES.

The Examiner's Answer states:

3. Appellant's arguments presented in the Appeal Brief of 11/25/08 have been fully considered but they are not persuasive. As set forth in the Board decision of 5/5/08, the Chen, Jung, Momemers and Miller patents teach the claimed key holder.

In response to appellant's arguments set forth on pages 10-11 of the brief, that the prior art of record fails to teach a D-ring, the examiner respectfully submits that while Chen and Jung do not teach the D-shaped ring as claimed (Chen's being C-shaped and Jung's triangularly shaped), Momemers clearly does teach a D-shaped loop or ring (3). Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1.42) also would be suitable for receiving a key ring. As stated by the Supreme Court in *KSR*, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." Furthermore, as discussed in the rejection above, while Jung's connecting member 14 is not D-shaped, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap therebetween for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Brief, page 11).

As stated by the Supreme Court in *KSR Int 7. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

To reiterate, Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, 11. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. See KSR, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ"). Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap therebetween for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1). Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1.42) also would be suitable for receiving a key ring. As stated by the Supreme Court in KSR, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

In response to appellant's remarks set forth on page 13 of the brief, regarding the rejection of claims 2 and 4 further in view of Miller, it is noted that appellant has not argued these rejections separately, thus no rebuttal is deemed necessary.

Accordingly, it is maintained that the prior art of record is properly combinable and teaches the structure and method of the instant claimed invention. Pp.7-10.

The claims on this appeal are not those on the prior appeal, and the Examiner has failed to construct the claims as they would be interpreted in the light of the specification by one of ordinary skill in the art. The Examiner has not and cannot comply with our request to quote verbatim the language in the references corresponding to the limitations in the claims. Nor has the Examiner satisfied her burden by showing "some articulated

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Page : 10

Attorney's Docket No. 08914-009001

reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Page : 11

Attorney's Docket No. 08914-009001

CONCLUSION

In view of the foregoing authorities and reasoning and that in our brief, the decision of the Examiner finally rejecting the claims should be reversed.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing Order No. 08914-009001.

Respectfully submitted,
FISH & RICHARDSON, P.C.

4 August 2009
Date: _____

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Enc. D definition

Answers.com®

d

Did you mean: [calcium](#) (element – in chemistry), [D](#) (technology), [D](#) (abbreviation), [Dominion Resources Inc](#), [D](#) (abbreviation), [D](#) (investment) [More...](#)

Dictionary: d¹ or D (dē) 

n., pl. d's or D's also ds, or Ds.

1. The fourth letter of the modern English alphabet.
2. Any of the speech sounds represented by the letter *d*.
3. The fourth in a series.
4. Something shaped like the letter D.
5. D The lowest passing grade given to a student in a school or college.
6. *Music.*
 - a. The second tone in the scale of C major or the fourth tone in the relative minor scale.
 - b. A key or scale in which D is the tonic.
 - c. A written or printed note representing this tone.
 - d. A string, key, or pipe tuned to the pitch of this tone.

Celtic Mythology: D

The fourth letter of the English alphabet is represented by dair [[oak](#)] in the [ogham](#) alphabet of early [Ireland](#).

Columbia Encyclopedia: D

D, fourth letter of the [alphabet](#). It corresponds to the Greek delta. It is a usual symbol for a voiced dental or, as in English, alveolar stop. The capital represents in [musical notation](#) a note in the scale and in Roman numerals the number 500.

Law Dictionary: D.A.

Abbreviation for [District Attorney](#).

Veterinary Dictionary: d

Symbol, *deci-*; 2'-deoxyribo.


Music: D

1. "Deutsch". D numbers are used instead of [opus](#) numbers to catalogue works by Schubert **2.** The key of D.

Wikipedia: D

For other uses of "D", see [D \(disambiguation\)](#).

For the emoticon [:D](#), see [Emoticon](#). (For [technical reasons](#), [:D](#) redirects here.)

 Look up [D](#) or [d](#) in [Wiktionary](#), the free dictionary.

Dd Dd

Basic Latin alphabet

Aa	Bb	Cc	Dd	
Ee	Ff	Gg	Hh	Ii Jj
Kk	Ll	Mm	Nn	Oo Pp